

## REMARKS

Claims 1-27 are currently pending in the present application (hereinafter, "*Painter*"). Of these pending claims, claim 21 is independent. Claims 22-27 depend from claim 21. Claims 1-20 have been withdrawn, claims 26-27 have been added. Claims 21 and 24 have been amended. No new matter is added by these amendments. Applicants respectfully requests allowance of all the pending claims in view of the subsequent remarks regarding the above-mentioned independent claims.

### **I. Claim Amendments**

Claim 21 has been amended to clarify that two sets of selection criteria are applied to qualification form data. The first selection criteria are more stringent than the second selection criteria. The first selection criteria are applied to the qualification form data, qualification forms that match the first selection criteria can be sent along to one or more financial service providers. The qualification form data that did not match the first selection criteria is then filtered by second selection criteria. This second application of less stringent criteria identifies qualification forms that might still be desirable to a financial service provider, even though the qualification forms did not match the first selection criteria.

Claims 26 and 27 further clarify that a threshold can be applied to the qualification form data, whereby criteria can be applied only to those qualification forms that received less than a threshold number of offers from financial service providers.

Support for these amendments can be found in the as filed application page 4, line 10 – page 5, line 3; page 21, line 17 – page 26, line 17; and Figures 1, 20, and 21. No new matter is added by these amendments.

**II. 35 U.S.C. § 101 Rejections**

Claims 21-25 were rejected as being directed to non-statutory subject matter. The claims have been amended to remove this limitation and the Applicants request removal of the rejection. Applicant has amended independent claim 21 (from which claims 22-25 depend) to recite that the steps incorporate a computer. Applicants request withdrawal of the rejection and allowance of all pending claims.

**III. 35 U.S.C. § 102 Rejections**

In the Office Action claims 21-25 were rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent Publication No. 2002/0072975 (hereinafter, “*Steele*”). Since claim 21 is an independent claim and the remaining claims are dependent, the comments below will focus on independent claim 21.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). The test is the same for a process. Anticipation requires identity between the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the

field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). In summary, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention. Moreover, “every element of the claimed invention must be literally present, arranged as in the claim. ... The identical invention must be shown in as complete detail as is contained in the patent claim.” *See, e.g., Richardson v. Suzuki Motor Company Co.* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

*Steele* teaches an “Anonymous Transaction System.” The contribution made by *Steele* is providing a central location for storage of consumer data (divided into a personal profile and an anonymous profile). A credit report associated with a consumer also stored and a supplier can access the anonymous profile along with the credit report. This reduces the negative impact on the consumer’s credit score because of repeated requests for a credit report from a credit reporting agency, yet still enables a consumer to provide the credit report to several suppliers.

*Steele* enables a supplier to search the entire set of anonymous profiles and credit reports for the purposes of making an offer to a consumer. This is markedly different than the presently claimed invention of *Painter*. There is no teaching in *Steele* of *automatic* application of selection criteria as presently claimed, nor is there any teaching in *Steele* of multiple searches to identify consumers that might not otherwise fit a stringent selection as presently claimed. *Steele* merely allows manual searches against a database with no teachings of targeting consumers that did not automatically match a first set of selection criteria. Furthermore, there is no teaching in *Steele* of tracking consumers that received less than a threshold amount of offers, and specifically including those consumers in future searches. Accordingly, applicants request withdrawal of the rejection and allowance of all pending claims.

An anticipation rejection is unfounded in the absence of a teaching of all the claim limitations. As the Court noted in *In re Fine*, “dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988). Using this same rationale, dependent claims cannot be anticipated if the independent claims from which they depend are not anticipated. As described above, *Steele* does not teach all the claim limitations of the independent claims and the combination with the other cited references does not teach all the claim limitations of the independent claims. Applicants therefore respectfully assert that all pending claims are in condition for allowance and request removal of the outstanding rejections.

No fee is believed to be due in connection with this submission. However, if a fee is due, the Commissioner is hereby authorized to charge any such fee or credit any overpayment to Deposit Account No. 14-0629. Respectfully submitted,

Ballard Spahr LLP

/Charley F. Brown #52,658/  
Charley F. Brown  
Registration No. 52,658

Ballard Spahr LLP  
Customer No. 23859  
(678) 420-9300 (phone)  
(678) 420-9301 (fax)